

REMARKS

Claims 9, 11, 12, 14, 15 and 17 are pending.

The Examiner's allowance of claim 15 is noted with appreciation.

Claims 9, 11, 12 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,839,814 to Steidel in view of U.S. Patent No. 4,830,269 to Jenkins. The applicant respectfully submits that claims 9, 11, 12 and 14 are not unpatentable over Steidel in view of Jenkins.

With respect to claim 9, and by dependency claim 11, Steidel fails to disclose the claimed steps of extending a web through a first printing station, an adhesive patch station for applying adhesive and a patch, a die cutting station, and then a second printing station. Instead, Steidel merely discloses different modular web processing units. Jenkins also fails to disclose the methods recited in claims 9 and 11. With respect to claim 12, and by dependency claim 14, both Steidel and Jenkins fail to disclose the claimed methods.

Although Steidel discloses that one of its modules could be a diecut module, another a lithographic print module, another a gluing module, and another a "placing" module, there is no disclosure of a particular arrangement of these modules that would result in the methods recited in claims 9, 11, 12 and 14.

As the Office action recognizes, Steidel states that "A new line may be created by unplugging unwanted modules and wheeling them away, wheeling and plugging in any desired additional modules, and wheeling the modules into any desired order. A user may begin with one or a few modules and add modules anytime desired." (Col. 6, ll. 35-40) However, as discussed above, Steidel fails to disclose any particular arrangements of the modules that would perform the methods recited in claims 9, 11, 12 and 14.

The Office action proposes rearrangement of the modules disclosed in Steidel, but fails to identify a motivation or reason for such proposed rearrangements in Steidel. As stated in the MPEP (§ 2144.04.IV.C), "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's

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specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In addition, Steidel fails to disclose that its lithographic printing module or dot matrix printer is capable of printing on anything other than the form. More specifically, Steidel fails to disclose that its print modules are capable of printing on the credit cards or glassine that is placed by the "placing" module. In contrast, claims 9 and 12 recite a second printing station for printing on selected areas of one or both of the web or patch material.

For the reasons set forth above, claims 9, 11, 12 and 14 are believed to be allowable, and reconsideration and allowance of claims 9, 11, 12 and 14 are respectfully requested.

Respectfully submitted,

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